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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,694	11/25/2003	William T. Ball	P06474US3	6303
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ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			EXAMINER PRUNNER, KATHLEEN J	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/721,694

Applicant(s)

BALL, WILLIAM T.

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The replacement drawings were received on June 27, 2005. These drawings are disapproved for the reasons noted in the attached "Notice of Draftsperon's Patent Drawing Review", form PTO-948.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, (A) the "drain pipe having an inverted L-shape", as called for by claim 1; (B) the "drain pipe ... including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system", as called for by claim 1; (C) the "fluid drain system", as called for by claim 1; (D) "a pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises a threaded portion", as called for by claim 2; (E) "a plumbing test system", as called for by claim 2; (F) a pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises an ... threaded portion", as called for by claim 2; (G) "the cap assembly contains a cap", as called for by claim 2; and (H) "the sealing material is composed of a material capable of sealing the first end when the cap is threaded onto the first end", as called for by claim 2, must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

#### *Response to Amendment*

4. In the amendment filed June 27, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (A) the sentence "A drain pipe 34 adapted to be in communication with said drain port 28 and said overflow port 30." (note lines 4-6 of the first new paragraph after line 26 on page 4); (B) the sentence "The drain pipe 34 having an inverted L-shape, including a horizontal leg 37A extending into and through the overflow port 30 of the bathtub 18, and a vertical leg 37B extending downwardly for connection to a fluid drain system 38." (note lines 6-9 of the first new paragraph after line 26 on page 4); (C) a "flexible sealing membrane 66 secured to the cap 52" (note lines 14-15 of the first new paragraph after line 26 on page 4); (D) "a sealing member 66 secured to the cap 52" (note line 6 of the second new paragraph after line 26 on page 4); and (E) "wherein a portion of the cap assembly 52, 66 is composed of a material capable of sealing the first end 37A when the cap 52 is threaded onto the first end 37A" (note lines 9-11 of the second new paragraph after line 26 on page 4).

Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New claim 4 calls for “a temporary closure device for a bathtub”. However, the originally filed disclosure fails to support or describe such a “a temporary closure device for a bathtub”. Therefore, claim 4 is directed to new matter.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 calls for “the sealing material [member] is composed of a material capable of sealing the first end when the cap is threaded onto the first end”. However, the originally filed disclosure fails to describe or support that the sealing material or member “is composed of a material capable of sealing the first end when the cap is threaded onto the first end”. Additionally, the originally filed disclosure fails to describe or support what type of material is capable of forming such a sealing material or member and yet be “capable of sealing”. Hence the originally filed disclosure is insufficient to permit the person skilled in the art to make and use the claimed invention without undue experimentation.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 2 contains a term lacking proper antecedent basis. The claim recites the limitation "the sealing material" in line 12. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102 and 103*

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. The following is a quotation of 35 U.S.C. 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1 is rejected under 35 U.S.C. 102(b) or 103(a) as being unpatentable over Ball. Ball discloses an overflow system for a bathtub 18 which has a bottom or base 26, adjacent side walls 22 and end walls 24 (note Fig. 2), a drain port 28 in the bottom 26, and an overflow port 30 in one of the end walls 24 having the claimed features including a drain pipe (constituted by pipes 32, 34, 36 and 38) adapted to be in communication with the drain port 28 and the overflow port 30 (note Fig. 2), the drain pipe 34 having an inverted L-shape including a horizontal leg extending into and through the overflow port 30 of the bathtub 18 (note Fig. 2) and a substantially vertical leg 34 extending downwardly for connection to a fluid drain system; and a

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cap (constituted by plate 70) threadably mounted (via screws 78) on an end of the horizontal leg extending through the overflow port 30 (note Figs. 1 and 2); the cap 70 having an opening 72 in its circular planar end (note Fig. 4) with a thin flexible sealing membrane (constituted by flexible diaphragm 64) secured to the cap 70 (via screws 78) and extending over the opening in the circular planar end (note Fig. 4). Ball further discloses that the cap 70 is mounted on the horizontal leg of the drain pipe 34 by the use of screws 78 which connect to the tabs 56 and 58 on the horizontal leg (note lines 30-46 in col. 2). Since the screws 78 of Ball are inherently threaded, it is considered that the perforations in tabs 56 and 58 (note Fig. 6) which engage the screws 78 are likewise inherently threaded.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delanoy in view of Lewis. Delanoy discloses a plumbing test system (note lines 9-13, 70-76 and 85-88 on page 1) having the claimed features including a pipe 1 having a first exposed end and a second end in communication with a fluid source (note lines 9-16 on page 1) wherein the first end comprises a threaded portion 3 (note Fig. 2); a cap assembly 6 threadably mounted on the first end and wherein a portion 10 of the cap assembly is composed of a material capable of sealing the first end (note lines 9-12 on page 1) when the cap is threaded onto the first end (note lines 70-73 on page 1); the cap assembly 6 contains a cap 7 having an opening in a planar end (note lines 59-62 on page 1) with a sealing member 10 secured to the cap 7 and extending over the opening in the planar end (note lines 56-62 on page 1). Delanoy discloses that the cap assembly 6 is screwed into the piping (note lines 9-12 on page 1). Although Delanoy fails to disclose that the cap assembly 6 is screwed onto the outer threads of the pipe, attention is directed to Lewis who discloses another plumbing bathtub test system (note ¶ 0008) having a cap assembly (constituted by test plug 8) which can be threadably mounted to the pipe elbow 20 either via outer screw threads or inner screw threads (note ¶ 0020). It would have been obvious to one of ordinary skill in the plumbing bathtub test system art, at the time the invention was made, to substitute for the inner screw mounting of the cap assembly into the pipe of Delanoy, the outer screw mounting of the cap assembly onto the pipe as, for example, taught by Lewis wherein so doing would amount

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to mere substitution of one screw attachment mechanism for another that would work equally well in the Delanoy device.

15. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being anticipated by Oropallo et al. in view of Delanoy. With respect to claim 1, Oropallo et al. disclose an overflow system for a bathtub 19 which has a bottom or base, adjacent side walls and end walls (note Fig. 1), a drain port 18 in the bottom, and an overflow port 11a in one of the end walls (note Fig. 1) having the claimed features including a drain pipe (constituted by pipes 11, 16, 17 and 20) adapted to be in communication with the drain port 18 and the overflow port 11a (note Fig. 1), the drain pipe 11 having an inverted L-shape including a horizontal leg extending into and through the overflow port 11a of the bathtub 19 (note Figs. 1 and 13) and a vertical leg 16 extending downwardly for connection to a fluid drain system; threads 41 on the horizontal leg extending through the overflow port 11a, and a cap 40 threadably mounted on an end of the horizontal leg extending through the overflow port 11a (note Fig. 13). Although Oropallo et al. fail to disclose that the cap 40 has an opening in its planar end, attention is directed to Delanoy who discloses another plumbing test system (note lines 9-13, 70-76 and 85-88 on page 1) utilizing a threaded cap 6 wherein the cap is in the form of a ring having an opening in a planar end and a sealing member in the form of a plate 10 extending across the face of the ring and secured to the cap and extending over the opening in the planar end to seal the same (note from lines 50-62 on page 1) in order to permit the easy placing of the connecting pipe after the test has been completed (note lines 9-16 on page 1). It would have been obvious to one of ordinary skill in the plumbing bathtub test system art, at the time the invention was made, to provide the cap 40 of Oropallo et al. with an opening in a planar end that is closed by a sealing member in view of the teachings of Delanoy in order to permit the easy placing of the connecting pipe after the test has been completed. With regard to claims 2 and 4, Oropallo et al. disclose a temporary closure device or plumbing test system (note lines 6-10 in col. 1) having the claimed features including a plumbing line or overflow pipe 11 having a first exposed end and a second end in communication with a fluid source (note lines 50-58 in col. 1) wherein the first end comprises an externally threaded



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portion 41 (note Fig. 13); and a cap assembly 40 threadably mounted on the externally threaded first end.

### *Response to Arguments*

16. Applicant's arguments filed June 27, 2005 have been fully considered but they are not deemed persuasive.

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion and motivation are found in the references themselves as clearly pointed out in the above rejection of the claims.

18. Applicant's arguments that the Ball reference “does not have either a horizontal leg extending into and through the overflow port of the bathtub” or “a cap threadably mounted on an end of the horizontal leg extending through the overflow port” have been carefully considered. However, the Ball reference clearly discloses these features in Figs. 1 and 2 as well in those portions of the reference noted in the above rejection of the claims.

### *Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Kathleen J. Prunner, whose telephone number is 571-272-4894.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu, can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JUSTINE R. YU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

10/3/05

  
Kathleen J. Prunner

September 30, 2005